

**Remarks/Arguments:**

Claims 54-73 are pending. Claims 54-73 have been allowed.

**INTRODUCTION**

The Office Action has closed prosecution of this application on the merits in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213 and has requested Applicants to suggest an interference under 37 C.F.R. §41.202(a). The information required by 37 C.F.R. § 41.202(a) is set forth below and in Appendices A through I under headings which correspond to the subsections of § 41.202(a) to facilitate consideration by the Examiner. For the Examiner's convenience, Applicants have also enclosed a completed Form PTO-850 for each Proposed Count.

Applicants are also submitting a Supplemental Information Disclosure Statement (IDS) along with a Request for Continued Examination (RCE) in accordance with 37 C.F.R. § 1.114 and MPEP § 706.07(h).

Finally, Applicants are also concurrently filing a petition to suspend further action on this application for 6 months pursuant to 37 CFR § 1.103(a). We are enclosing a copy of the petition (as concurrently filed) for your reference. In case the petition for a 6 month suspension of action is not granted, Applicants also request that this application be put into suspense for 3 months pursuant to 37 CFR § 1.103(c). As explained in more detail below, Applicants are presenting these suspension requests because they need time to investigate priority between the present application and the Marcade patent discussed below.

**COMPLIANCE WITH 37 C.F.R. § 41.202(a)**

**A. Sufficient Information To Identify The Patent  
With Which The Applicants Seek An Interference  
(37 C.F.R. § 41.202(a)(1))**

The patent which claims subject matter which interferes with subject matter claimed in the present application ("the Goicoechea application") is U.S. Patent No. 6,416,542 ("the Marcade patent"), which issued on July 9, 2002 to Marcade et al. for "MODULAR BIFURCATED INTRALUMINAL GRAFTS AND METHODS FOR DELIVERING AND ASSEMBLING SAME." The Marcade patent was issued from Application Serial No. 09/365,638 ("the Marcade application"), filed August 3, 1999.

**B. Presentation Of Proposed Counts (37 C.F.R. § 41.202(a)(2))**

Attached Appendix A sets forth two proposed counts. Proposed Count I is at least as broad as claim 1 of the Marcade patent. Proposed Count II is at least as broad as claim 16 of the Marcade patent. Claim 54 of the Goicoechea application corresponds exactly to Proposed Count I. Claim 58 of the Goicoechea application corresponds exactly to Proposed Count II.

**C. Identification Of All Claims That Applicants Believe Interfere And How The Claims Correspond To One Or More Counts (37 C.F.R. § 41.202(a)(2))**

Goicoechea application claims 54-57 interfere and correspond to Proposed Count I. Claim 54 of the Goicoechea application is identical to Proposed Count I. Claims 55-57 of the Goicoechea application are directed to the same patentable invention as Proposed Count I.

Goicoechea application claims 58-60 interfere and correspond to Proposed Count II. Claim 58 of the Goicoechea application is identical to Proposed Count II. Claims 59 and 60 of the Goicoechea application are directed to the same patentable invention as Proposed Count II.

Claims 1-15 of the Marcade patent interfere and correspond to Proposed Count I.

Claims 16-20 of the Marcade patent interfere and correspond to Proposed Count II.

**D. Claim Charts For Each Count Comparing At Least One Claim Of Each Party Corresponding To The Count (37 C.F.R. §41.202(a)(3))**

Appendix B is a claim chart comparing Goicoechea application claim 54 with Proposed Count I. Appendix C is a claim chart comparing Marcade claim 1 with Proposed Count I.

Appendix D is a claim chart comparing Goicoechea application claim 58 with Proposed Count II. Appendix E is a claim chart comparing Marcade claim 16 with Proposed Count II.

**E. Showing Why The Claims Of Each Party Interfere  
Within The Meaning Of § 41.203(a) (37 C.F.R. §41.202(a)(3))**

A comparison of Goicoechea claim 54 and Marcade claim 1 reproduced in Appendices B and C, shows the following equivalencies between them:

Goicoechea Claim 54	Marcade claim 1
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a base member
expandable radially between a collapsed configuration and an expanded configuration and	foldable radially between a collapsed configuration and an expanded configuration and
extending longitudinally between a proximal end and a distal end,	extending longitudinally between a proximal end and a distal end,
said prosthesis portion having a single inlet at said proximal end;	said base member having a single inlet at said proximal end;
a proximal prosthesis portion	a primary tubular limb
expandable radially between a collapsed configuration and an expanded configuration and	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	said primary limb having a single inlet at said proximal end and a single outlet at said distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said primary limb being formed separately from said base member and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said base member and said primary limb including
a flexible layer and	a flexible layer and
an expandable stent radially	an expandable stent radially

supporting said flexible layer along substantially the entire length thereof; and	supporting said flexible layer along substantially the entire length thereof; and
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

The comparison between Goicoechea claim 54 and Marcade claim 1 shows that each claim would, if prior art, have anticipated or rendered obvious the subject matter of the opposing party and vice versa.

A comparison of Goicoechea claim 58 and Marcade claim 16 reproduced in Appendices D and E, shows the following equivalencies between them:

Goicoechea claim 58	Marcade claim 16
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a base member
expandable radially between a collapsed configuration and an expanded configuration and	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end;	having a proximal end and a distal end;
a proximal prosthesis portion	a primary tubular limb
expandable radially between a collapsed configuration and an expanded configuration and	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said primary limb being formed separately from said base member and
being adapted to lie in the aorta with said proximal end pointing	being adapted to lie in the aorta with said proximal end pointing toward the

toward the heart and	heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said base member and said primary limb including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	an expandable stent radially supporting said flexible layer along substantially the entire length thereof;
at least one distal prosthesis portion	at least one secondary tubular limb
expandable radially between a collapsed configuration and an expanded configuration and	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said distal prosthesis portion including	said secondary tubular limb including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	connecting means for connecting said proximal end of said secondary limb to said distal end of said base member.

The comparison between Goicoechea claim 58 and Marcade claim 16 shows that each claim would, if prior art, have anticipated or rendered obvious the subject matter of the opposing party and vice versa.

**F. Explanation Why Goicoechea Will  
Prevail On Priority (37 C.F.R. § 41.202(a)(4))**

The present Goicoechea application is a continuation of Serial No. 08/463,987, filed June 5, 1995, now pending, which is a division of Serial No. 08/317,763, filed October 4,

1994, now U.S. Patent No. 5,609,627, which is a continuation-in-part of Serial No. 08/312,881, filed September 27, 1994, now pending. The present application is also a continuation-in-part of Serial No. 08/312,881.

Benefit is also claimed based on EP 94400284.9, filed February 9, 1994, and EP 94401306.9, filed June 10, 1994. On July 27, 2001 a claim of priority for these European applications was denied to a different inventive entity by the Board of Patent Appeals and Interferences in Patent Interference No. 104,192. The U.S. District Court for the District of Columbia affirmed the decision of the Board on March 31, 2006 in Civil Case No. 01-2015(RJL). The decision of the District Court has been appealed to the U.S. Court of Appeals for the Federal Circuit. Copies of the following documents are attached for the Examiner's convenience:

- Decision of the Board
- Memorandum Opinion of the District Court
- Final Judgment of the District Court

The Marcade patent is a continuation of Application No. 08/840,406, filed April 29, 1997, now U.S. Patent No. 5,993,481, which is a division of Application No. 08/393,701, filed February 24, 1995, now U.S. Patent No. 5,683,449.

**G. Claim Chart Showing The Written Description In The Goicoechea Specification For Each Claim Added To Provoke An Interference (37 C.F.R. § 41.202(a)(5))**

Appendix F is a chart providing an element-by-element recitation of the claims of the Goicoechea application identified in Section C as corresponding to proposed Counts I and II and an indication of the passages in the Goicoechea application where, at the very least, the claims find support.

**H. Charts Showing Where The Disclosure Provides A Constructive Reduction To Practice Within The Scope Of the Interfering Subject Matter For Each Constructive Reduction To Practice For Which Goicoechea Wishes To Be Accorded Benefit (37 C.F.R. § 41.202(a)(6))**

Appendices G, H, and I are charts providing an element-by-element recitation of the claims of the Goicoechea application and an indication of the passages in Serial No. 08/312,881, EP 94401306.0 and EP 94400284.9, respectively, where, at the very least, the disclosure provides constructive reduction to practice. This Goicoechea application should be accorded benefit of these prior applications in the declaration of interference. Accordingly, the

effective U.S. filing date of this Goicoechea application is September 27, 1994 and the effective foreign filing date of this Goicoechea application is February 9, 1994.

**REQUEST FOR CONTINUED EXAMINATION (RCE) AND  
INFORMATION DISCLOSURE STATEMENT (IDS)**

The Office Action mailed on February 22, 2006 closed prosecution on the merits in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213. The filing of an RCE is authorized by 37 C.F.R. § 1.114 after prosecution is closed by filing a submission and an appropriate fee. Prosecution is considered closed for purposes of filing an RCE when an Office Action closes prosecution in accordance with the practice under *Ex parte Quayle*. See, MPEP §706.07(h)I. A "submission" as used in 37 C.F.R. § 1.114 may be an information disclosure statement. If a reply to an Office Action is outstanding, the submission must also meet the reply requirements. Thus, where an Office Action is issued under *Ex parte Quayle*, the submission must include the reply required by the Office Action. 37 C.F.R. § 1.114(c); MPEP § 706.07(h)II.

Along with the present Response, Applicants are filing an RCE. Applicants have complied with the RCE submission requirements in 37 C.F.R. § 1.114 by filing an IDS concurrently with the filing of the RCE and by suggesting an interference under 37 C.F.R. § 41.202(a) as required by the Office Action.

**REQUEST FOR SUSPENSION OF ACTION**

The present application is a continuation application of Application No. 08/463,987 which is a division of Application No. 08/317,763, now U.S. Patent No. 5,609,627. On October 22, 2001, an assignment of the '627 patent to Scimed Life Systems, Inc. was recorded at reel/frame 012520/0229. An assignment recorded against an original application is applied to a division or continuation application. MPEP § 306. Therefore, the present application is currently assigned to Scimed Life Systems, Inc., a company that was renamed Boston Scientific Scimed, Inc. ("Boston Scientific").

The face of the Marcade '542 patent indicates that it is assigned to Endovascular Technologies, Inc. Endovascular Technologies, Inc. is a subsidiary of Guidant Corporation, and Guidant is the owner of the '542 patent. On April 21, 2006, Guidant merged with Boston Scientific.

Since the Marcade '542 patent is now owned by Boston Scientific or its affiliates, a declaration of an interference may not be appropriate in accordance with 37 C.F.R. § 41.206 and MPEP 2304.05. According to the MPEP, after a merger of two corporations,

the resulting corporation owns both applications. The new corporation is obligated to investigate priority. Once the corporation has had an opportunity to determine which application is entitled to priority, the corporation must elect between the applications or otherwise eliminate the need for an interference.

Boston Scientific has not yet been able to investigate priority between the present application and the Marcade '542 patent. Accordingly, Applicants request by separate petition filed concurrently, the PTO to suspend prosecution of this application for six months. Applicants also request a three month suspension in case the PTO declines to suspend prosecution for six months.

Suspension of action by the PTO is authorized by 37 C.F.R. § 1.103 under two circumstances.

**Request For Suspension Under 37 C.F.R. § 1.103(a),  
Suspension For Cause**

This subsection permits an applicant to request, and the PTO to grant, a suspension of action for good and sufficient cause. The Rule and MPEP § 709 require that a request for suspension for good and sufficient cause pursuant to subsection (a) must be presented as a petition in a separate paper that is accompanied by a petition fee. Accordingly, Applicants are concurrently filing a petition for a six month suspension pursuant to 37 C.F.R. § 1.103(a).

**Alternative Request For Suspension Under 37 C.F.R. § 1.103(c),  
Suspension Of Action After Request For RCE**

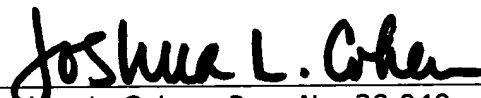
Suspension of action under 37 C.F.R. § 1.103(c) is requested pending a ruling on the separately filed petition for suspension for cause under 37 C.F.R. § 1.103(a) and in the event the petition for cause is denied. The request for suspension under § 1.103(c) may be granted for a period not exceeding three months by the PTO after the filing of an RCE. Applicants are requesting suspension for three months concurrently with the filing of an RCE in accordance with the Rule. The request for suspension is being made by checking the appropriate box on the accompanying PTO/SB/30, by filing an RCE in compliance with 37 C.F.R. § 1.114, by paying the appropriate fee for an RCE, and by paying the appropriate fee for the suspension request. Applicants request that the suspension be granted to enable Boston Scientific sufficient time investigate priority, as discussed above.



**CONCLUSION**

For the reasons set forth above, Applicants request that the PTO accept their suggestion of interference as a satisfactory submission under 37 C.F.R. § 41.202(a) and § 1.114, grant their request for continued examination (RCE), grant their request for suspension of action for 3 months, and grant their petition for suspension of action for a total of 6 months.

Respectfully submitted,



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Encls.: Appendix A-I  
PTO Form PTO-850 (Count I and Count II)  
Copy of Petition for Suspension of Action...(as filed)

SW/dhm

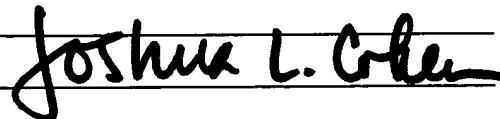
Dated: August 21, 2006

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The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

August 21, 2006



## **APPENDIX A**

### **PROPOSED COUNT I**

A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:

a prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and extending longitudinally between a proximal end and a distal end, said prosthesis portion having a single inlet at said proximal end;

a proximal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end, said proximal prosthesis portion being formed separately from said prosthesis portion and being adapted to lie in the aorta with said proximal end pointing toward the heart and sized to fit a diameter of the aorta;

each of said prosthesis portion and said proximal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and

joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

## **PROPOSED COUNT II**

A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:

a prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end;

a proximal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said proximal prosthesis portion being formed separately from said prosthesis portion and being adapted to lie in the aorta with said proximal end pointing toward the heart and sized to fit a diameter of the aorta;

each of said prosthesis portion and said proximal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;

at least one distal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said distal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and

connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.

## **APPENDIX B**

GOICOECHEA CLAIM 54	PROPOSED COUNT I
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a prosthesis portion
expandable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
extending longitudinally between a proximal end and a distal end,	extending longitudinally between a proximal end and a distal end,
said prosthesis portion having a single inlet at said proximal end;	said prosthesis portion having a single inlet at said proximal end;
a proximal prosthesis portion	a proximal prosthesis portion
expandable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said prosthesis portion and said proximal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

### **APPENDIX C**

<b><u>MARCADE CLAIM 1</u></b>	<b><u>PROPOSED COUNT I</u></b>
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a base member	a prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
extending longitudinally between a proximal end and a distal end,	extending longitudinally between a proximal end and a distal end,
said base member having a single inlet at said proximal end;	said prosthesis portion having a single inlet at said proximal end;
a primary tubular limb	a proximal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said primary limb having a single inlet at said proximal end and a single outlet at said distal end,	said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,
said primary limb being formed separately from said base member and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said base member and said primary limb including	each of said prosthesis portion and said proximal prosthesis portion including

a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
joining means for intraluminally joining said distal end of said primary limb to said proximal end of said base member.	joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

## **APPENDIX D**

GOICOECHEA CLAIM 58	PROPOSED COUNT II
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a prosthesis portion
expandable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end;	having a proximal end and a distal end;
a proximal prosthesis portion	a proximal prosthesis portion
expandable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said prosthesis portion and said proximal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	an expandable stent radially supporting said flexible layer along substantially the entire length thereof;

at least one distal prosthesis portion	at least one distal prosthesis portion
expandable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said distal prosthesis portion including	said distal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.



## **APPENDIX E**

<b><u>MARCADE CLAIM 16</u></b>	<b><u>PROPOSED COUNT II</u></b>
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a base member	a prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end;	having a proximal end and a distal end;
a primary tubular limb	a proximal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said primary limb being formed separately from said base member and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said base member and said primary limb including	each of said prosthesis portion and said proximal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	an expandable stent radially supporting said flexible layer along substantially the entire length thereof;
at least one secondary tubular limb	at least one distal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and

having a proximal end and a distal end,	having a proximal end and a distal end,
said secondary tubular limb including	said distal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
connecting means for connecting said proximal end of said secondary limb to said distal end of said base member.	connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.

## **APPENDIX F**

### **APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF THE GOICOECHEA APPLICATION**

<b>Application claim</b>	<b>Disclosure of Goicoechea Application</b>
<b>Claim 54</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 29, lines 5-21; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 29, line 22 to page 30 line 7
extending longitudinally between a proximal end and a distal end,	page 29, lines 5-13; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4; Figs. 14-20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 29, lines 10-14; page 32, lines 16-17; page 27, lines 3-8; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 29, lines 8-18; Fig. 1B; page 32, lines 16-17; page 27, lines 19-25; Fig. 1A
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 26 to page 5, line 13
<b>Claim 55</b>	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 26 to page 5, line 13
<b>Claim 56</b>	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 30, line 23 to page 31, line 4
<b>Claim 57</b>	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 27, lines 14-18
<b>Claim 58</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7

a prosthesis portion	page 25, lines 22 to page 26, line 8; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end;	Figs. 1A, 6, 14-20
a proximal prosthesis portion	Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4
each of said prosthesis portion and said proximal prosthesis portion including	
A flexible layer	page 27, lines 3-8; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 27, lines 19-25; Figs. 5-7
at least one distal prosthesis portion	page 29, line 19 to page 30, line 7; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration and	page 27, lines 19-27; page 29, line 22 to page 30, line 7
having a proximal end and a distal end,	Figs. 1A, 1B, 6, 14-20
said distal prosthesis portion including	

a flexible layer and	page 27, lines 3-13; page 29, lines 10-14; Fig. 6
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1A, 1B, 6, 14-20
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 4, line 26 to page 5, line 13; page 26, line 25 to page 27, line 2; Figs. 1A, 1B, 6; page 29, line 22 to page 30, line 7
<b>Claim 59</b>	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 29, line 22 to page 30, line 7
<b>Claim 60</b>	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 26, lines 19-25; page 29, lines 16-17

**APPENDIX G**

**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF U.S.**  
**APPLICATION NO. 08/312,881**

<b>Application claim</b>	<b>Disclosure of Application No. 08/312,881</b>
<b>Claim 54</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 24, line 22 to page 25, line 14; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 25, line 16 to page 26, line 1
extending longitudinally between a proximal end and a distal end,	page 24, line 22 to page 25, line 4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 8-13; page 19, line 3 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 11
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 11

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer	page 24, line 27 to page 25, line 4; page 22, lines 19-23; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 25, line 16 to page 26, line 1; page 23, lines 9-15; Figs. 5-7
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 7 to page 5, line 10
<b>Claim 55</b>	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 7 to page 5, line 10
<b>Claim 56</b>	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 26, lines 16-25
<b>Claim 57</b>	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 23, lines 3-7
<b>Claim 58</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 21, lines 4-18; Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end;	Figs. 1A, 6



a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 8-13; page 19, line 6 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 11
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 11
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 22, lines 19-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 23, lines 9-15; Figs. 5-7
at least one distal prosthesis portion	page 22, lines 4 to 16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17; page 25, line 16 to page 26, line 1.
having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer	page 22, line 18 to page 23, line 1; page 24, line 27 to page 25, line 4; Fig. 6

and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1B and 6
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 9-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6; page 4, line 7 to page 5, line 10
<b>Claim 59</b>	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 25, line 16 to page 26, line 1; page 4, line 7 to page 5, line 10
<b>Claim 60</b>	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 22, lines 8-9

## **APPENDIX H**

### **APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF EP APPLICATION NO. 94401306.9**

<b>Application claim</b>	<b>Disclosure of EP Application No. 94401306.9</b>
<b>Claim 54</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 24, line 22 to page 25, line 4; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 25, line 16 to page 26, line 1
extending longitudinally between a proximal end and a distal end,	page 24, line 22 to page 25, line 4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 7-13; page 19, line 3 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 20
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 24, line 27 to page 25, line 4; page 22, lines 18-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 25, line 16 to page 26, line 1; page 23, lines 9-17; Figs. 5-7
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 7 to page 5, line 12
<b>Claim 55</b>	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 7 to page 5, line 12
<b>Claim 56</b>	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 26, lines 16-25
<b>Claim 57</b>	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 23, lines 3-7
<b>Claim 58</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 21, lines 4-18; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 23, lines 9-17

having a proximal end and a distal end;	Figs. 1A, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 7-13; page 19, line 3 to page 24, line 20
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 20
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 20
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 22, lines 18-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 23, lines 9-15; Figs. 5-7
at least one distal prosthesis portion	page 22, lines 4-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration	page 23, lines 9-17; page 25, line 16 to page 26, line 1
and having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer and	page 22, line 18 to page 23, line 1; page 24, line 27 to page 25, line 4; Fig. 6

an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1B and 6
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 9-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6; page 4, line 7 to page 5, line 12
<b>Claim 59</b>	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 25, line 16 to page 26, line 1; page 4, line 7 to page 5, line 12
<b>Claim 60</b>	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 22, lines 8-9

**APPENDIX I**

**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF  
EPO PPLICATION NO. 94400284.9**

<b>Application claim</b>	<b>Disclosure of EPO Application No. 94400284.9</b>
<b>Claim 54</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5, 6
a prosthesis portion	page 21, lines 10-24; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 22, line 1-13
extending longitudinally between a proximal end and a distal end,	page 21, lines 10-14; page 23, lines 1-4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration	page 20, lines 4-10
and having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 15, lines 4-9; page 15, line 24 to page 18, line 13
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 20, line 12 to page 21, line 8
sized to fit a diameter of the aorta;	page 20, line 12 to page 21, line 8

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 19, lines 15-19; Figs. 5, 6; page 23, lines 1-4
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 20, lines 4-10, Figs. 5, 6; page 22, lines 1-13; Fig. 6
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 1 to page 6, line 6
<b>Claim 55</b>	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 1 to page 6, line 6
<b>Claim 56</b>	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 23, line 6-15
<b>Claim 57</b>	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 19, lines 25 to page 20, line 2
<b>Claim 58</b>	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5, 6
a prosthesis portion	page 17, line 25 to page 18, line 13; Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 20, lines 4-10
having a proximal end and a distal end;	Figs. 1A, 6
a proximal prosthesis portion	Figs. 1A, 6



expandable radially from a collapsed configuration and an expanded configuration	page 20, lines 4-10
and having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion	page 15, lines 4-9; page 15, line 24 to page 18, line 13
and being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 20, line 12 to page 21, line 8
sized to fit a diameter of the aorta;	page 20, line 12 to page 21, line 8
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer	page 19, lines 15-19; Figs. 5, 6
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 20, lines 4-10; Figs. 5, 6
at least one distal prosthesis portion	page 19, lines 1-13; page 22, lines 1-13; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 20, lines 4-10; page 22, lines 1-13
having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer and	page 23, lines 1-4; Fig. 6; page 19, lines 15-23
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Fig. 6

connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 1-13; Figs. 1A, 1B, 6; page 19, lines 6-13; page 4, line 1 to page 6, line 6
<b>Claim 59</b>	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 4, line 1 to page 6, line 6; page 22, lines 1-13
<b>Claim 60</b>	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 19, lines 5-6